

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. THURBER and ROBERT D. BAGBY

Appeal No. 1998-1930
Application No. 08/517,183¹

ON BRIEF

Before MEISTER, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

¹ Application for patent filed August 21, 1995.

Appeal No. 1998-1930
Application No. 08/517,183

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 2 to 8, 11 to 14, 18 and 20 to 26, as amended subsequent to the final rejection.² These claims constitute all of the claims pending in this application.

We REVERSE.

² In the amendment after the final rejection (Paper No. 8, filed May 9, 1997) the appellants canceled claims 15 and 16 and added new claims 25 and 26.

BACKGROUND

The appellants' invention relates to a fishing rod. An understanding of the invention can be derived from a reading of exemplary claims 21 and 24, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Muk Kim	5,090,149	Feb. 25,
1992		
Evers	Des. 346,754	May 10, 1994

Claims 2 to 8, 11 to 14, 18 and 20 to 26³ stand rejected under 35 U.S.C. § 103 as being unpatentable over Muk Kim in view of Evers.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

³ The examiner's statement of the rejection (answer, p. 4) does not include pending claims 25 and 26 but does include canceled claims 15 and 16. However, the body of the rejection (answer, p. 12) does refer to claims 25 and 26. Accordingly, we consider claims 25 and 26 to be before us in this appeal.

rejection, we make reference to the examiner's answer (Paper No. 11, mailed September 24, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 10, filed July 10, 1997) and reply brief (Paper No. 12, filed November 28, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 2 to 8, 11 to 14, 18 and 20 to 26 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Furthermore, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies

in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Muk Kim discloses a pipe for a fishing rod. As shown in Figure 1, the pipe includes a cylinder 1 having an outer surface, and a flexible rectangular wrapper 9 positioned about the outer surface. The wrapper has a predetermined design thereon and is covered with a transparent preservative coating. Muk Kim teaches (column 2, lines 45--48) that in the preferred embodiment the wrapper 9 carries a predetermined design 3 which displays pictures of fish which are dyed on the wrapper.

Evers depicts an ornamental design for a rod measurer and weigher.⁴ As shown in Figures 1-6, the rod measurer and weigher includes a simulation of a fish.

The examiner determined (answer, p. 5) that

[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the mark or design on the wrapper or cylindrical body of Muk Kim such that it represents the torso of a selected species of fish in view of Evers in order to provide both a pleasing ornamental design which is realistic and an indicator as to what species of fish the rod is intended to be used in catching.

The appellants argue (brief, pp. 5-6 and 10) that the applied prior art does not suggest the claimed subject matter. We agree. In our view, the above-noted determination of the examiner has not been supported by any evidence that would have led an artisan to arrive at the claimed invention. In our opinion, the only suggestion for modifying Muk Kim in the manner proposed by the examiner stems from hindsight knowledge

⁴ In our view, Evers does not disclose a fishing rod (see page 5 of the brief) or a fishing body (see pages 4-5 of the answer).

derived from the appellants' own disclosure.⁵ The examiner's use of impermissible hindsight is made clear from the above-noted determination of obviousness since one of the examiner's reasons (i.e., to provide an indicator as to what species of fish the rod is intended to be used in catching) for modifying Muk Kim is clearly not found in the applied prior art but is found only the appellants' disclosure. With regard to the other reason (i.e., to provide a pleasing ornamental design which is realistic) for modifying Muk Kim, it is our belief that an artisan would not have been motivated from the combined teachings of Muk Kim and Evers to have modified Muk Kim's fishing rod to contain a simulation of a fish mounted about Muk Kim's cylinder 1. It follows that we cannot sustain the examiner's rejection of claims 2 to 8, 11 to 14, 18 and 20 to 26.

⁵ The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 2 to 8, 11 to 14, 18 and 20 to 26 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

Appeal No. 1998-1930
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Page 10

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APPEAL NO. 1998-1930 - JUDGE NASE
APPLICATION NO. 08/517,183

APJ NASE

APJ CRAWFORD

APJ MEISTER

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 13 Apr 99

FINAL TYPED:

THREE PERSON CONF.